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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78761852
Applicant	Davies Gate LLC
Applied for Mark	DAVIES GATE SUGAR PLUM
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Submission	Appeal Brief
Attachments	DAVIES GATE SUGAR PLUM - appeal brief - 06-02-07.pdf (3 pages)(16752 bytes)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Mark: DAVIES GATE SUGAR PLUM) Examining Attorney: Mrs. A.D. Saunders
)
Applicant: DAVIES GATE LLC) Law Office: 109
)
Serial No.: 78/751,852)
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Filed: November 28, 2005)
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Class: 03)
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APPEAL BRIEF

This Appeal is brought from the Examining Attorney's Office Action dated March 19, 2007 refusing Applicant's Request for Reconsideration. The Examining Attorney has refused to register the Applicant's mark, alleging that a portion of it is descriptive under Section 2(e). For all the reasons stated below and in Applicant's Response to Office Action filed on November 9, 2006 and Response to Final Office Action filed on March 5, 2007, Applicant traverses the Examining Attorney's rejection and requests that it be reversed and that Applicant's mark be allowed registration. Applicant's Notice of Appeal was filed on March 5, 2007, the Appeal was suspended pending the Examining Attorney's action on the Request for Reconsideration filed on March 5, 2007. Applicant received notification on April 3, 2007, that the Appeal had been reinstituted and its Appeal Brief was due in sixty days or on June 2, 2007, which fell on a Saturday. Thus, this Appeal Brief is timely filed on the next business day, Monday, June 4, 2007.

ARGUMENT

1. No *prima facie* case of descriptiveness has been established.

The Examining Attorney contends that the wording SUGAR PLUM is merely descriptive of "the color and/or scent of the goods". Applicant contends that the Examining Attorney has failed to make a *prima facie* case of descriptiveness as required by law and has

failed to put into the record any evidence that the wording “SUGAR PLUM” describes either a scent or a color. On the other hand, Applicant has put into the record the www.dictionary.com definition of “SUGAR PLUM” which is a small candy.

2. “A small candy” is not descriptive of skin care products.

Although the Examining Attorney has put into the record evidence of third party use of the wording “SUGAR PLUM” in connection with cosmetics, Applicant has shown that the vast majority of these third party uses were descriptive use to explain the scent or color of the product. They were legitimate trademark use with initial capitalization or title case and/or were suggestive use meant to elicit in the consumer a certain feeling about the products.

The Examining Attorney alleges that because Applicant’s website describes its goods as being fragrant with “ripe plums with light notes of luscious peach and hints of sugar sweet vanilla”, the goods can be described as having the scent of “SUGAR PLUMS” and, therefore the wording “SUGAR PLUM” is descriptive and must be disclaimed. Applicant contends it is a non-sequitur to conclude that because the goods are fragrant with plums, peach and vanilla, they can be described as having the scent of a sugar plum candy. There is simply no basis in the record for this conclusion. Candies do not have a known scent that is used in the cosmetic industry and they do not have a known specific color. Sugar plum candies do not smell like ripe plums or sugar sweet vanilla.

The wording “SUGAR PLUM” is a unitary phrase with a well known dictionary meaning, a small candy, and a unique commercial impression. It is impermissible for the Examining Attorney to dissect Applicant’s mark into its component parts and use the individual meaning that applies to those words when they appear alone to the analysis of descriptiveness of the unitary phrase. The words have different meanings when they are alone than they do when they appear together. In Applicant’s mark, they appear together. The mark must be viewed as a whole and the meaning and commercial impression of the unitary wording “SUGAR PLUM” must be considered in determining descriptiveness. The wording, meaning a small candy, is simply not descriptive of skin care products, it is suggestive at most.

In accordance with precedent, any reasonable doubt as to whether a mark is suggestive or descriptive must be resolved in favor of Applicant. For all of the foregoing reasons, Applicant should not be required to disclaim the term “SUGAR PLUM” as it relates to Applicant’s goods.

Alternative Argument

Alternatively, if the Board determines that the evidence of record does not support the fact that “SUGAR PLUM” is a unitary phrase, with a well-known dictionary meaning of “a small candy” and a unique commercial impression, but that the evidence of record clearly shows that consumers view the phrase as two separate words referring to the commodity “sugar” and the “plum” fruit, rather a small candy, then Applicant as a last resort is willing to disclaim the word “PLUM”. Because “SUGAR” does not have a scent or a color and has no descriptive meaning as applied to Applicant’s goods, a disclaimer of “SUGAR” should not be required. Nonetheless, for purposes of a descriptiveness analysis Applicant strongly asserts that the mark should be viewed as a whole with its accompanying meaning and commercial impression and should not be dissected into two separate words with different meanings and an entirely different commercial impression.